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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,635	09/08/2003	Randy Johnson	SYN.P.US0038	2817

26360 7590 10/07/2005

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/657,635		JOHNSON ET AL.	
	Examiner		Art Unit	
	Lynda M. Salvatore		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/17/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8 drawn to a woven ground cover classified in class 442, subclass 208
 - II. Claims 9-10 drawn a method of facilitating tree growth and preventing weed growth, classified in class, 504, subclass various
2. The inventions are distinct, each from the other because:

Inventions of Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the woven degradable/non-degradable fabric can be employed in variety of disposable composites which require biodegradability such those found in personal care articles. In addition, the woven degradable/non-degradable fabric can be employed as stent/graft structures such as those used found in the medical field. In addition, the method of claim 9 can be performed using a non-woven degradable/non-degradable fabric.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Donald Bobak on 9/8/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-10 are withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 2 is indefinite because it is not clear to the Examiner how the degradable portion can also comprise non-degradable yarns.

8. Claim 4 is indefinite because it is not clear to the Examiner which polyolefin in claim 3 Applicant is referring. For purposes of examination, both the degradable polyolefin and the non-degradable polyolefin can be polypropylene.

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minoru et al., JP 11-124854

The published Japanese patent application teaches a woven mat comprising biodegradable weft yarns and non-bio degradable warp yarns (abstract, section 0010 and figure 3). Minoru et al., teach employing a polyethylene as the non-degradable warp yarn (section 0010). With regard to the limitation of providing from 5-75% degradable portions, it is the position of the Examiner that a woven mat comprising weft biodegradable yarns would inherently make up at least 50% of the woven structure.

Although, the published Japanese abstract fails to teach the degrading time period property as set forth in claim 7, it is reasonable to presume that said property is inherent to the woven mat taught by Minoru et al. Support for said presumption is found in the use of like materials such as a non-degradable and degradable yarns and the use of like processes such as

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forming a woven mat, which would inherently provide for the claimed degradation time.

Applicant is invited to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed property would obviously have been present once the woven mat of Minoru et al., is provided. *In re Best* 195 USPQ 433

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minoru et al., JP 11-124854.

Minoru et al., does explicitly teach the claimed weaving pattern set forth in claim 2, however, it is the position of the Examiner that it would be obvious to one having ordinary skill in the art to optimize the ratio of degradable and non-degradable yarns in the woven fabric as a function of desired degradability over time and to control the strength longevity of the fabric.

13. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minoru et al., JP 11-124854 as applied to claims 1 and 2 above and further in view of Bechtold, US 6,126,861.

Minoru et al., does not specifically teach providing a polypropylene yarn comprising a UV stabilizer, however, the patent issued to Bechtold teaches a polypropylene based UV light stabilizing composition comprising an amine based UV light absorbing structure (column 1, 15-column 7, 65). The composition is suitable to form yarns (column 7, 55-60).

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Therefore, motivated by the desire to provide a yarn having UV absorbing abilities, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to form the non-degradable yarn taught by Minoru et al., with the polypropylene based UV light stabilizing composition taught by Bechtold. Specific motivation to provide such a yarn is found in the claimed use of the woven article (e.g., exposed to outdoor sunlight).

Conclusion


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 26, 2005

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TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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